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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,209	10/01/2003	Noel P. Horkan	HOR 101	9682

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EXAMINER

ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,209

Applicant(s)

HORKAN, NOEL P.

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is important to recognize that a Trademark or Trade Name is used to identify a source of goods, and not the good themselves. Thus a Trademark or Trade Name does not identify or describe the goods associated with the Trademark or Trade Name. See definitions of Trademark and Trade Name in MPEP 608.01(v). A Trademark or Trade Name used in a claim as a limitation to identify or describe a particular material or product does not comply with the requirements of 35 USC 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the Trademark or Trade Name cannot be used properly to identify any particular material or product. In fact, the value of the Trademark or Trade Name would be lost to the extent that it became descriptive of a product, rather than used as an

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identification of a source or origin of a product. Thus, the use of a Trademark or Trade Name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the Trademark or Trade Name. If the Trademark or Trade Name appears in a claim and is not intended as a limitation in the claim, then the question of why it is in the claim arises and whether or not its presence causes confusion as to the scope of the claimed subject matter. See claims 3, 4, 8 and 9.

4. Claim 1 recites the limitation "the fingerpads" in lines 5 and 6. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 6 recites the limitation "the fingerpads" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turangan (5,316,294) in view of Rudell et al (5,195,745).

Regarding claim 1, Turangan shows a football kicking training aid comprising in combination: a football (21) having at least one attached patch (fastener 43), said patch or patches covering one or both pointed ends of said football (see figure 4), said patch or patches having a plurality of either male or female fastener elements thereon (loop fastener 43); a flexible glove (10) having lateral areas positioned adjacent the finger pads (hook fasteners 44) of

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a user wearing said glove (10); a pad on the said lateral area of the index finger of said glove (see figure 2), said pad having a plurality of mating fastener elements thereon complementary to said fastener elements on said patch, said mating elements on said glove worn by a user releasably engaging said mating elements on said patch located at the upper end of said football (see figures 2 and 3), whereby said mating of said complementary fastener elements urges a user to properly support said football. Turangan does not disclose expressly the use of thimbles instead of gloves. Rudell et al shows a throwing projectile such as a football (10, 19 or 42) having a plurality of patches (44) and corresponding glove (34), wrist strap (28) or finger band (67) worn by each user. In view of Rudell et al it would have been obvious to select any one of the hand/finger coverings to use with the football of Turangan, since one of ordinary skill in the art, would have expected Turangan's invention to perform equally well with anyone of the above hand/finger coverings, because they all perform the same function of protecting the hand and fingers from the football. Therefore, it would have been an obvious matter of design choice to modify Turangan to obtain the invention as specified in claim 1.

It should be noted: a recitation of the intended use, in the instant case *for kicking by another player, at said patch at said upper end by a user's finger pad within said glove, and to continue supporting said football until the kicking action has been completed* of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

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See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 2, Turangan shows said mating fastener elements disengage from said complementary mating elements upon a player handling said football.

Regarding claims 3 and 4, Turangan shows said mating elements on said patch or patches comprise hook (44) loop (43) elements (column 2, lines 46-53).

Regarding claim 5, Turangan shows the material of said glove is formed of an elastic material which would include natural and/or synthetic rubber.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Turangan (5,316,294).

Regarding claim 6, Turangan discloses a football kicking training aid comprising in combination: a football (21) having at least one attached patch (fastener 43), said patch or patches covering one or both pointed ends of said football (see figure 4), said patch or patches having a plurality of either male or female fastener elements thereon (loop fastener 43); a flexible glove (10) having a plurality of fingers (44), said fingers having lateral areas positioned adjacent the finger pads (hook fasteners 44) of a user wearing said glove (10); a pad on the said lateral area of the index finger of said glove (see figure 2), said pad having a plurality of mating

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fastener elements thereon complementary to said fastener elements on said patch, said mating elements on said glove worn by a user releasably engaging said mating elements on said patch located at the upper end of said football (see figures 2 and 3), whereby said mating of said complementary fastener elements urges a user to properly support said football.

It should be noted: a recitation of the intended use, in the instant case *for kicking by another player, at said patch at said upper end by a user's finger pad within said glove, and to continue supporting said football until the kicking action has been completed* of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 7, note the rejection of claim 2.

Regarding claim 8, note the rejection of claim 3.

Regarding claim 9, note the rejection of claim 4.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA
12 October 2004


MITRA ARYANPOUR
PATENT EXAMINER